

Application Serial No. 09/370,619
Attorney Docket No. 114459-05

the Amendment of April 12, 2004. Because the "application ... has received one or more actions by some other examiner," who determined that the claims were properly examined together, restriction among claims 186-297 is not now warranted.

II. The Groups Are Not Properly Divided Because The MPEP Instructs That "No Reasons Exist For Division" Between These Related Groups

When properly classified, all claims may be searched together. Because they are "related," no restriction is warranted.

MPEP § 803 states the requirements for a restriction requirement (emphasis added):

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05 - § 806.05(i)) and
- (2) There must be a serious burden on the examiner if restriction is not required (see MPEP §803.02, §806.04(a)-(j), §808.01(a) and §808.02).

MPEP § 803 clarifies (emphasis added):

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

As shown below, all groups are searchable in the same one or two subclasses. The Restriction Requirement admits that all groups are "related." Therefore, there is no "serious search burden," and no restriction is proper.

A. Group I (claims 186, 287-297): the Classification Proposed in the Restriction Requirement is Incorrect – Group I Should be Searched in 705/35

The Restriction Requirement of July 2004 proposes to classify Group I in class 705, subclass 308. The Patent Office's web site indicates that **there is no such class and subclass**.

Applicant suggests that Group I should be searched in class 705, subclass 35, or subclass

1.¹ Claim 186, one of the independent claims of the group, recites as follows:

¹ This discussion is directed to assisting the Examiner in framing an efficient search, and therefore is intended to direct the Examiner to the place where the best prior art is likely to be. It should be understood that this is not a limiting discussion of the invention or the scope of the claims.

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186. A method, comprising the steps of:
in a market for loans or lines of credit offered to consumers in which transactions occur among market participants in distinct first and second sectors, providing intermediation services for transactions in each of the two sectors; the first sector being retail origination of the loans or lines of credit, the intermediation services in the first sector including:
during an application process for loans or lines of credit offered by a plurality of offerors, obtaining information describing applications made by a plurality of applicants for the loans or lines of credit, the information relating to the qualifications of the applicants relative to underwriting standards of a plurality of lenders;
storing the application information in a database;
submitting the obtained information for matching against underwriting standards of the offerors;
matching the applicants' information against underwriting standards of a plurality of lenders, and identifying to each applicant, from among those lenders having underwriting standards that the respective applicant meets, an indicium of the identity of the lender that has the best combination of low interest rate and fees; and
essentially contemporaneously with the closing of each of a plurality of the loans or lines of credit, updating the database with information describing the closed loans or lines of credit; and
the second sector being a secondary market for buying and selling of the loans or lines of credit, the intermediation services in the second sector including:
providing intermediation services in the second sector pursuant to a predetermined pricing schedule providing credits for transaction fees paid by a party for intermediation of transactions in the first sector for redemption against fees payable by the party for intermediation of transactions in the second sector;
offering to parties in the second sector real-time or near real-time access to the information in the database, the offer being under a prearranged pricing schedule providing reductions in the price of the information as fees increase for intermediation services provided for transactions in the first sector.

The subject matter of Group I is searchable in subclass 35, and also in subclass 1. The relevant class and subclass definitions are as follows:

CLASS 705 DATA PROCESSING: FINANCIAL, BUSINESS PRACTICE, MANAGEMENT, OR COST/PRICE DETERMINATION

SECTION I - CLASS DEFINITION

This is the generic class for apparatus and corresponding methods for performing data processing operations, in which there is a significant change in the data or for performing calculation operations wherein the apparatus or method is uniquely designed for or utilized in the practice, administration, or management of an enterprise, or in the processing of financial data.

This class also provides for apparatus and corresponding methods for performing data processing or calculating operations in which a charge for goods or services is determined.

Response to Restriction Requirement

This paper dated August 9, 2004

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This class additionally provides for subject matter described in the two paragraphs above in combination with cryptographic apparatus or method.

SCOPE OF THE CLASS

1. The arrangements in this class are generally used for problems relating to administration of an organization, commodities or financial transactions.

1 AUTOMATED ELECTRICAL FINANCIAL OR BUSINESS PRACTICE OR MANAGEMENT ARRANGEMENT:

This subclass is indented under the class definition. Subject matter ... in which there is a significant change in the data or for performing calculation operations wherein the apparatus or method is uniquely designed for or utilized in the practice, administration, or management of an enterprise, or in the processing of financial data.

(3) Note. The arrangements in this and its indented subclasses are generally used for problems relating to administration of an organization, commodities, financial transactions, or recreation.

35 Finance (e.g., banking, investment or credit):

This subclass is indented under subclass 1. Subject matter drawn to a computerized arrangement for planning the disposition or use of funds or securities, or extension of credit.

B. Group II (claims 187-239 and 252-263): the Classification Proposed in the Restriction Requirement is Incorrect – Group II Should be Searched in 705/35

The Restriction Requirement of July 2004 proposes to classify Group II in class 707, subclass 37. The Patent Office's web site indicates that **there is no such class and subclass.**

Further, the subject matter of Group II does not fall within class 707. The definition of class 707 reads as follows:

CLASS 707: DATA PROCESSING: DATABASE AND FILE MANAGEMENT OR DATA STRUCTURES

SECTION I - CLASS DEFINITION

This is the generic class for data processing apparatus and corresponding methods for the retrieval of data stored in a database or as computer files.

This class provides for data processing means or steps for organizing and inter-relating data or files (e.g., relational, network, hierarchical, and entity-relationship models).

This class also provides for data processing means or steps for generic data, file and directory upkeep, file naming, and file and database maintenance including integrity consideration, recovery, and versioning.

RELATIONSHIP WITH OTHER CLASSES

A. Database and File Accessing

- (2) Note. The combination of details of database technology with the business data processing is classified in the business art. ...
(4) Note. This class area is directed to generic methods and apparatus for accessing and retrieving data housed in either databases or files. ...

C. File and Database Maintenance

- (1) Note. This class area is directed to means and steps for handling of generic files and databases only in computers and digital data processing systems. For the purpose of these definitions a generic file is defined as a named collection of data. File content and database content authoring, generating, producing, and editing in information processing applications art areas, such as, for example, business data processing machine translation, graphics processing, simulation, animation and software development, is classified elsewhere.

Claim 225, one of the independent claims of Group II, recites as follows:

225. A method for performance by a provider of intermediation services, comprising the steps of:

in a market for a class of financial products in which transactions occur in distinct first and second sectors; the first and second sectors being origination and secondary trading of products of the class among market participants, providing intermediation services for transactions in each of the two sectors; and

offering information for sale to parties conducting transactions in the second sector, the information being information captured in the course of providing intermediation services in the first sector, the offer being under a prearranged pricing schedule providing reductions in the price of the information as fees increase for intermediation services provided for transactions in the first sector.

Claim 225 recites no limitations relating to "organizing and inter-relating data or files," or any other technology generally associated with implementation of databases. Rather, claim 225 is directed to business use of databases, "information processing applications art areas, such as, for example, business data processing," and thus should be "classified elsewhere." Applicant suggests that Group II should be searched in class 705, subclass 35 ("Finance (e.g., Banking, Investment Or Credit)") or subclass 1 ("Automated Electrical Financial Or Business Practice Or Management Arrangement").

C. Group III (claims 241-251): the Classification Proposed in the Restriction Requirement is Incorrect – Group III Should be Searched in 705/35

The Restriction Requirement of July 2004 proposes to classify Group III in class 707, subclass 10. As noted above in connection with Group II, the subject matter of Group III does not fall within class 707. Further, the definition of subclass 10 reads as follows:

10 Distributed or remote access:

This subclass is indented under subclass 1. Subject matter directed to management of distributed database data and file access and retrieval, and retrieval of database data and files from a centralized or remote site.

No claim of Group III is limited to “distributed databases.”

Claim 241, one of the independent claims of Group III, recites as follows:

241. A computer programmed to:

provide intermediation data processing functions for transactions in a class of financial products in distinct first and second sectors, the first and second sectors being origination and secondary trading of products of the class among market participants; and

provide access to information to parties conducting transactions in the second sector and to record charges for that access, the information being information captured in the course of providing intermediation services in the first sector.

Applicant suggests that classification of Group III into class 705, subclass 35 is correct. Subclass 1, though less specific, would also be correct.

D. Group IV (claims 264-286): the Classification Proposed in the Restriction Requirement is Incorrect – Group IV Should be Searched in 705/35

The Restriction Requirement of January 2003 proposes to classify Group IV in class 705, subclass 1. This is fairly accurate; however, subclass 35 is more specific and is more correct. In pertinent part, the definition for subclasses 1 and 35 is set forth above at page 3. Claim 264, one of the independent claims of Group IV, recites as follows:

264. A method for performance by a provider of computer information services, comprising the steps of:

during an application process for financial products offered by a plurality of offerors, obtaining information describing solicitations made by a plurality of applicants for the financial products and submitted for matching against underwriting standards of the offerors, and storing the solicitation information in a database;

essentially contemporaneously with the closing of each of a plurality of the financial products, updating the database with information describing the closed financial products; and

making the database available to parties on a secondary market for the financial products.

Claim 264 relates to "Finance (e.g., banking, investment or credit)," the subject matter of subclass 35. A search limited only to subclass 1 may well miss the most pertinent art.

E. As Correctly Classified for Search, Groups I, II, III and IV are Properly Examined Together

The Restriction Requirement concedes that all four Groups are "related" (paragraph 7). "Related" groups may not be restricted when they are classified together for search. MPEP § 808.02 ("Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions."). Because all claims should be searched in the same search class and subclass (705/35 or 705/1), no reasons exist for restriction.

III. A Search of Group I Will Likely Involve A Search of Groups II, III and IV

Applicant suggests that the search burden is unlikely to be "serious" when a search of claim 186 (the independent claim of Group I) will nearly inevitably result in a search of the other groups. For example, claim 264 (Group IV) appears nearly word-for-word within claim 186 (Group I) (compare underlined portions of 186 to 264):

186. A method, comprising the steps of:
in a market for loans or lines of credit offered to consumers in which transactions occur among market participants in distinct first and second sectors, providing intermediation services for transactions in each of the two sectors;
the first sector being retail origination of the loans or lines of credit, the intermediation services in the first sector including:
during an application process for loans or lines of credit offered by a plurality of offerors, obtaining information describing applications made by a plurality of applicants for the loans or lines of credit, the information relating to the qualifications of the applicants relative to underwriting standards of a plurality of lenders;

storing the application information in a database;

submitting the obtained information for matching against underwriting standards of the offerors;

matching the applicants' information against underwriting standards of a plurality of lenders, and identifying to each applicant, from among those lenders having underwriting standards that the respective applicant meets, an indicium of the identity of the lender that has the best combination of low interest rate and fees; and

essentially contemporaneously with the closing of each of a plurality of the loans or lines of credit, updating the database with information describing the closed loans or lines of credit; and

the second sector being a secondary market for buying and selling of the loans or lines of credit, the intermediation services in the second sector including:

providing intermediation services in the second sector pursuant to a predetermined pricing schedule providing credits for transaction fees paid by a party for intermediation of transactions in the first sector for redemption against fees payable by the party for intermediation of transactions in the second sector;

offering to parties in the second sector real-time or near real-time access to the information in the database, the offer being under a prearranged pricing schedule providing reductions in the price of the information as fees increase for intermediation services provided for transactions in the first sector.

264. A method for performance by a provider of computer information services, comprising the steps of:

during an application process for financial products offered by a plurality of offerors, obtaining information describing solicitations made by a plurality of applicants for the financial products and submitted for matching against underwriting standards of the offerors, and storing the solicitation information in a database;

essentially contemporaneously with the closing of each of a plurality of the financial products, updating the database with information describing the closed financial products; and

making the database available to parties on a secondary market for the financial products.

Because claim 186 is in the elected group, any search of Group I nearly inevitably results in a search of Group IV as well. Similarly, the subject matter of Groups II and III will inevitably be searched in a search of Group I. Similarly, a search of claims 288, 289, 295 and 296 (from Group I) will result in searches of at least the independent claims of the other Groups.

Because no "serious" burden exists in searching Groups II, III and IV simultaneously with Group I, the claims are appropriately examined together.

Further, Applicant suggests that the search burden between these Groups is unlikely to be "serious" in light of the Office Action of October 2002 that searched all of these claims together, and applied overlapping combinations of references.

In view of the lack of "serious burden," Applicant requests that the Restriction be withdrawn.

IV. Conclusion

Should the requirement for restriction be made final, the Examiner is respectfully requested to state on the record that the claims in each group are patentable (novel and nonobvious) over each other.

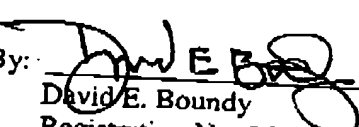
Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114459-05.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: August 9, 2004

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